

REMARKS

Applicant notes that the publication (US 2007/0125689 A1) does not include changes made in the Preliminary Amendment / Substitute Specification filed on February 7, 2006.

We request that the Examiner acknowledge that the changes have been entered.

In the Office Action dated April 22, 2009, the Examiner rejected claims 15-17 and 27-29 under 35 USC 102(b) as being anticipated by Baumann U.S. Patent No. 5,538,626 (Baumann).

Claims 18, 19, 33 and 34 were rejected under 35 USC 103(a) as being unpatentable over Baumann (5,538,626) in view of Jainek U.S. Patent No. 6,746,604.

Claims 20, 21 and 31 were rejected under 35 USC 103(a) as being unpatentable over Baumann (5,538,626) in view of Koivula et al (6,187,191) and Steger, Jr., et al (6,554,140).

Claims 22-26, 30 and 32 were rejected under 35 USC 103(a) as being unpatentable over Baumann (5,538,626) in view of Koivula (6,187,191).

Claim 35 was rejected under 35 USC 103(a) as being unpatentable over Baumann (5,538,626) in view of Jainek (6,746,604) as applied above with respect to claim 34 and further in view of Koivula (6,187,191).

By the present response, applicant has amended the independent claims to more clearly and distinctly defined the claimed invention.

Independent claim 15 defines a fluid filter having a companion mounting flange. The filter includes a filter housing having an internal space for receiving a filter element. There is a filter socket located at one end of the filter housing which has a mounting flange that can, in a sealing manner, be connected to the companion flange on the associated apparatus to form a flange connection. There is at least one first fluid duct in the filter housing for supplying fluid to be filtered from the apparatus to the fluid filter and one second fluid duct in the filter housing for discharging filtered fluid from the filter to the apparatus extending through the flange connection. The filter socket has an enlarged opening in the mounting flange leading to the first and second fluid ducts. A sealing plate is formed separately from the filter socket and is configured to be inserted into the enlarged opening in the filter socket mounting flange and arranged to close off at least one section of at least one of the fluid ducts. The sealing plate has at least one through opening that is sealed directly against the companion flange and is arranged flush with an apparatus-side fluid duct such that fluid flowing through the through opening is led

immediately, directly and exclusively into the apparatus-side fluid duct. A surface area of the sealing plate, as seen on a plane of the flange connection, is smaller than a surface area of the mounting flange. The sealing plate is inserted in the filter socket in a sealing manner by means of a separate sealing member extending around a perimeter of the sealing plate, such that the sealing plate forms a part of the filter socket.

This structure defined by claim 15 is distinct and different from the structure disclosed by Baumann, and provides various advantages not provided by the Baumann structure.

Claim 15 specifically and positively defines the sealing plate as being a separate component from the filter socket which is configured to be inserted into the enlarged opening in the filter socket mounting flange. Claim 15 also defines that the sealing plate is inserted in the filter socket in a sealing manner by means of a separate sealing member extending around a perimeter of the sealing plate. Baumann discloses a face wall 20 which the Examiner equates with the claimed sealing plate. The face wall 20 is integrally formed with the filter housing 2 and not as a separate component, nor is there a separate sealing member. As noted at paragraph [0029] (as published) (page 6 final 3 lines of the Substitute Specification) by producing the sealing plate as a separate component from the filter socket, the filter socket can be demolded without any difficulties in an injection-molding production process. This permits an arrangement where the through opening is offset from the oil duct, as is shown in Fig. 1 of the present application. Such a construction would be very difficult, if possible at all, to mold in an injection-molding process, thus providing a significant advantage for the structure as defined in claim 15.

As noted in paragraph [0042] (paragraph bridging pages 8 and 9 of the substitute specification) "any offset between the oil duct 14 and the through opening 34 to the companion flange of the internal combustion engine can be bridged by means of the simple sealing plate 3 which represents an inexpensive component, this allowing easy adaption of the position of the oil ducts inside the mounting flange 21 of the filter socket 10 to a connection diagram predetermined on the side of the internal combustion engine." Thus, the filter socket can easily be modified to work on different engines or be moved to accommodate obstructions in the motor compartment, by adjusting the position of the through opening in the companion flange, without modifying the entire rest of the filter socket. The structure of Baumann does not provide such an advantage.

Claim 15 specifically defines the surface area of the sealing plate being smaller than a surface area of the mounting flange. The equivalent structure, as defined by the Examiner, in Baumann is the face wall 20 which forms the end of the filter housing 2. The outer periphery of the face wall 20 is coterminous with the outside diameter of the filter housing, thus comprising the same size as the "mounting flange." In fact, at col. 6, lines 20-22, Baumann states: "at its outside, i.e. at the side directed towards the left in the drawing, the face wall 20 carries an annular channel 21 in which a seal ring 22 made of an elastomer is arranged." Thus, the face wall 20 extends radially outwardly beyond the channel 21, to the circumferential edge of the filter housing 2. The Examiner's position that the wall surrounds the wall 20 is incorrect. Hence, the face wall 20 of Baumann is not smaller in surface area than the mounting flange 24. They are identical in size. As noted in paragraph [0006] (final paragraph of page 3 of the Substitute Specification) this smaller size allows the sealing plate to be received within the filter housing, making the fluid filter more compact and lighter in weight. This is an advantage not provided by Baumann.

Claim 15 defines that the sealing plate has a through opening that is sealed directly against the companion flange and being arranged flush with an apparatus-side fluid duct such that fluid flowing through the through opening is led immediately, directly and exclusively into the apparatus-side fluid duct.

The Examiner had taken the position that claim 15 as previously drafted did not specifically define that the intake channel was separately sealed against the flange. Claim 15 does now specifically define such structure, which is distinguishable over the structure disclosed by Baumann.

The intake channel 23 of Baumann is not separately sealed against the flange 7, but rather relies on the seal ring 22 carried on the face wall 20. The filter housing 2 is secured by means of the screw 3, however, the position of the filter housing in a circumferential direction is purely incidental. That is, it is only by chance whether, after the filter is attached at the counter flange 7, whether the inlet channel 23 is aligned (flush) with the intake channel 73. For this reason, the face wall 20 is not planar where it abuts the counter flange 7, but rather it forms a circular ring channel so that the inlet channel 23 will communicate with the intake channel, despite their misalignment. Thus, in Baumann, the fluid flowing through the through opening is not led

immediately, directly and exclusively into the apparatus-side fluid duct, but rather is permitted to flow into the circular ring channel sealed by the seal ring 22.

For each of these separate reasons considered separately or in combination, claim 15 is patentably distinguishable over Baumann, and therefore applicants submit that claim 15 and its dependent claims are in allowable condition.

With regard to independent claim 33, the Examiner took the position that Baumann disclosed all of the claimed structure other than a drain duct extending through the flange connection between the mounting flange and the companion flange. Claim 33 has been more clearly defined, in accordance with the amendments to claim 15 discussed above, and therefore applicants submit that Baumann does not disclose all of the claimed structure of claim 33. Specifically, claim 33 defines that the sealing plate is formed separately from the filter socket and is configured to be inserted into the enlarged opening in the filter socket mount flange. As noted above, Baumann discloses a face wall 20 that is formed integrally with the filter housing. Claim 33 specifically defines that the sealing plate is inserted in the filter socket in a sealing manner by means of a separate seal member extending around a perimeter of the sealing plate. Again, no such structure is disclosed in Baumann where the face wall is formed integrally with the filter housing.

Claim 33 also defines that the sealing plate has at least one through opening that is sealed directly against the companion flange and is arranged flush with an engine-side fluid duct such that fluid flowing through the through opening is led immediately, directly and exclusively into the engine-side fluid duct. As noted above, in Baumann, the intake channel 23 is not separately sealed against the flange 7, but rather relies on the seal ring 22 carried on the face wall 20. The filter housing 2 is secured by means of the screw 3, however, the position of the filter housing in a circumferential direction is purely incidental. That is, it is only by chance whether, after the filter is attached at the counter flange 7, whether the inlet channel 23 is aligned (flush) with the intake channel 73. For this reason, the face wall 20 is not planar where it abuts the counter flange 7, but rather it forms a circular ring channel so that the inlet channel 23 will communicate with the intake channel, despite their misalignment. Thus, in Baumann, the fluid flowing through the through opening is not led immediately, directly and exclusively into the apparatus-side fluid duct, but rather is permitted to flow into the circular ring channel sealed by the seal ring 22.

For each of these reasons, considered separately or in combination, applicants submit that Baumann does not disclose the structure of claim 33. Jainek is used only for the showing of a drain duct at an end of the housing. Jainek does not teach or suggest the other structural elements discussed above that are missing from the structure disclosed by Baumann. For each of these additional reasons, applicants submit that a combination of Baumann and Jainek does not disclose the structure of claim 33, and therefore claim 33 and each of its dependent claims are patentably distinguishable over the references relied on by the Examiner.

New claim 36 specifically defines that the sealing plate has only one opening for communicating with only one of the first, second, and third fluid ducts that the seal member includes openings for the remaining two of the first, second and third fluid ducts which extend through the flange connection laterally offset from and outside a perimeter of the sealing plate. Such a structural arrangement is not shown or suggested by the references relied on by the Examiner, and therefore applicants further submit that claim 36 is patentably distinguishable over the cited references.

The Examiner relied on the additional teachings of Koivula and Steger in combination with the teachings of Baumann in an attempt to develop a prima face case of obviousness of some of the dependent claims. These two additional references do not provide any of the missing teachings relative to independent claims 15 or 33 as discussed above, and therefore independent claims 15 and 33 are deemed patentable over all of the references relied on by the Examiner. In view of the patentable condition of claims 15 and 33, applicant submits that each of the claims depending on claims 15 and 33 are patentable as well.

In view of the above discussion, applicant submits that the application is now in condition for allowance and therefore requests the Examiner to reconsider the rejections made, to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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